



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,684	12/10/2001	Tomomi Izuna	16869S-038700US	9312

20350 7590 05/18/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,684

Applicant(s)

IZUNA ET AL.

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-9-02; 07-26-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

Claim 13 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 28, 2005.

Applicants' election without traverse of Group 1, claims 1-12 in the reply filed on February 28, 2005 is acknowledged.

Applicants are respectfully requested to cancel the non-elected claim in response to the Office Action.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on October 9, 2002 and July 26, 2004 are being considered by the examiner.

Drawings

The drawings filed on December 10, 2001 are acceptable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing

Art Unit: 3627

for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences

Art Unit: 3627

(BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore,

Art Unit: 3627

the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the *Freeman-Walter-Abele* test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1-12 have no connection to the technological arts. The preamble of the claims and the steps of the method have no connection to a computer or technology. For example in claim 1, the steps of issuing a first response and issuing a second response are broadly interpreted as manual steps. Therefore, the claims are directed towards non-statutory subject matter, i.e. not within technological arts. To overcome this rejection, the Examiner recommends that Applicant amend the

Art Unit: 3627

preamble of the claim and the steps to better clarify which steps are being performed within the technological arts, such as using a digital computing device.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 4, the recitation of "an address" is unclear. For examination purposes, the Examiner will interpret address as email address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,868,397 to McCaslin in view of U.S. Patent No. 5,574,380 to Dubin and U.S. Patent Application No. 2003/0208365 to Avery .

Art Unit: 3627

Regarding claims 1-3, 6-12, McCaslin discloses a method for supporting received orders of a transformer, comprising: issuing a first response including a desired inquiry of a customer relating to an installation date (col. 12, lines 37-49; Figure 17) of a transformer from a sales department to the customer (col. 5, lines 32-35; col. 6, lines 24-34; col. 9, lines 47-63; Figure 7; col.7, lines 66 – col. 8, line 2; col.8, lines 16-21); and in response to the customer's reply, issuing a second response including the installation date of the transformer from a measurement department in charge of the transformer (col. 6, line 63- col. 7, line 24; col. 7, lines 66 – col. 8, line 2; col.8, lines 16-21; col. 5, lines 32-40); and issuing a third response including an implementation date of the previous inspection from the measurement department (col. 5, lines 21-40; col. 6, line 63 – col. 7, line 7; col. 9, lines 36-47; Figure 6).

However, McCaslin does not disclose a measuring circuit of the transformer. McCaslin discloses electrical distribution equipment including, for example transformers, capacitors, regulators reclosures, and voltage regulators and any other equipment used in connection with a business (col. 5, lines 9-13).

Dubin, on the other hand, teaches the measuring circuit of the transformer (abstract). Dubin teaches a current measurement circuit which integrates the signal of the mutually coupled transformer (col. 1, lines 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of McCaslin, to include the measurement circuit of a transformer, as taught by Dubin, in order to avoid the

Art Unit: 3627

problems of complexity and duplication of components, thus, providing cost efficiency (Dubin col. 1, lines 49-54).

Furthermore, the combination of McCaslin does not disclose a web site and a mail server. McCaslin discloses a server through a network such as a local area network, a wide area network, a token ring network and the like (col. 7, lines 64-65).

Avery, on the other hand, teaches the web site (web site, paragraph 5) and a mail server (paragraphs 79, 81, 83 and 95).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify McCaslin to include, the web site and a mail server, as taught by Avery, in order to provide global communication.

Regarding claims 4-5, McCaslin discloses a method for supporting received orders of a transformer, comprising: issuing a first response including a desired inquiry of a customer (service center) relating to an installation date (col. 12, lines 37-49; Figure 17) of a transformer from a sales department to the customer (col. 5, lines 32-35; col. 6, lines 24-34; col. 9, lines 47-63; Figure 7; col.7, lines 66 – col. 8; line 2; col.8, lines 16-21); wherein the first response is transmitted to the customer so as to guide the customer's reply to the first response to the department in charge of the transformer (col. 6, line 63 – col. 7, line 24; col. 9, lines 53-64) and to issues a second response including the installation date of the transformer from a department in charge of the transformer (col. 6, line 63- col. 7, line 24; col. 7, lines 66 – col. 8, line 2; col.8, lines 16-21; col. 5, lines 32-40).

Art Unit: 3627

However, McCaslin does not disclose a measuring circuit of the transformer.

McCaslin discloses electrical distribution equipment including, for example transformers, capacitors, regulators reclosures, and voltage regulators and any other equipment used in connection with a business (col. 5, lines 9-13).

Dubin, on the other hand, teaches the measuring circuit of the transformer (abstract). Dubin teaches a current measurement circuit which integrates the signal of the mutually coupled transformer (col. 1, lines 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of McCaslin, to include the measurement circuit of a transformer, as taught by Dubin, in order to avoid the problems of complexity and duplication of components, thus, providing cost efficiency (Dubin col. 1, lines 49-54).

Furthermore, the combination of McCaslin does not disclose a web site, a mail server and an address. McCaslin discloses a server through a network such as a local area network, a wide area network, a token ring network and the like (col. 7, lines 64-65).

Avery, on the other hand, teaches the web site (web site, paragraph 5), a mail server, and address (paragraphs 79, 81, 83 and 95).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify McCaslin to include, the web site, a mail server, and address, as taught by Avery, in order to provide global communication.

Conclusion

Art Unit: 3627

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,061,609 to Kanoi et al. discloses an electrical power distribution monitoring system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
May 16, 2005

Michael Cuff 5/16/05
MICHAEL CUFF
PRIMARY EXAMINER